

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SPRANZA, Joseph J. Attorney Docket Nos. SDEV-1-1003
Serial No.: 10/697,444 Group Art Unit: 3763
Filing Date: October 29, 2003 Examiner: Christopher Koharski
Title: SAFE TROCHAR WITH GUIDE FOR PLACEMENT OF SURGICAL DRAINS

RENEWED PETITION UNDER 37 C.F.R. § 1.137(b)

TO THE DEPUTY COMMISSIONER FOR PATENT EXAMINATION POLICY:

The applicant petitions the Office of the Deputy Commissioner for Patent Examination Policy to revive the above-identified nonprovisional application pursuant to 37 CFR § 1.137(b) on the grounds that the failure to reply was unintentional. This Renewed Petition is accompanied by: (1) the required Reply (filed herewith); (2) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) is unintentional; and (3) a statement that a terminal disclaimer required pursuant to 37 CFR 1.137(d) was not necessary because this is not a utility application filed before June 8, 1995.

The showing requirement is met by submission of statements of fact establishing that the delay in filing the reply was unintentional and inadvertent. The attached Declaration of Mrs. Susan Spranza, widow of the deceased inventor Mr. Joseph J. Spranza, III ("Mr. Spranza"), with Exhibits, supports this Petition. Additionally, co-inventor Dr. Robert S. Namba ("Dr. Namba") joins in this Petition for revival. This Renewed Petition corrects the prior petition filed August 26, 2008 (*See* Exhibit H) by (1) demonstrating that the cause of the entire delay resulting in failure to reply in a timely fashion to the Office Action was unintentional; and (2) submitting the signed declarations of both Susan Spranza and Dr. Robert Namba averring to the facts contained therein.


The above referenced U.S. Application Serial No. 10/697,444 ("444") was the result of a collaboration between Mr. Spranza and Dr. Namba, and is a Continuation of an earlier filed Continuation-in-Part application. The events that led up to the filing and unintentional abandonment of this application are detailed below.

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Until his death, Mr. Spranza was the founder, CEO and lead scientific developer of the company Special Devices, Inc. ("SDI"), located in Grass Valley, California. SDI was a small company that designed and manufactured surgical devices, primarily for orthopedic surgery.

On May 17, 2002, Dr. Namba and Mr. Spranza entered into a joint development agreement to develop and manufacture improvements of the invention known as the Safe Trochar (hereinafter "EuTrochar"). This agreement was memorialized in later agreements of June 16, 2003 and June 24, 2003 which were executed by co-inventors Dr. Namba and Mr. Spranza. Exhibit A includes true and accurate copies of the joint development agreements memorializing the May 17, 2002 agreement between Dr. Namba and Mr. Spranza. (See Spranza Decl., ¶2 and Namba Decl., ¶3)

The EuTrochar is the subject matter of parent U.S. Application Serial No. 09/697,463 ('463) filed October 26, 2000 (our Ref. #: SDEV-1-1001) which issued on September 2, 2003 as U.S. Patent No. 6,613,039 ('039) to Dr. Namba. During the pendency of this original parent Application '463 Dr. Namba and Mr. Spranza began joint development of the improvements of the EuTrochar. On July 5, 2003, Mr. Spranza and Dr. Namba filed U.S. Application Serial No. 10/613,387 ('387) (our Ref. #: SDEV-1-1002) prior to the parent application's ('463) issuance. Mr. Spranza was the leading force behind filing for patent protection on their invention and he managed all correspondence with the U.S.P.T.O. with respect to this and all later filed applications. Application '387 was abandoned on February 16, 2007 in favor of the instant U.S. Application Serial No. 10/697,444 ('444), filed on October 29, 2003. (See Namba Decl., ¶3.)

On April 24, 2006 Mr. Spranza attempted to file a preliminary amendment to the claims in Application '444. However, the paper submitted was not clearly identified as a "Preliminary Amendment" to the claims in Application '444. (See Exhibit B, a true and correct copy of the Applicants' letter dated April 24, 2006, as downloaded from U.S.P.T.O. PAIR on March 9, 2009). The Applicants' paper did, however, indicate that the Examiner should "[p]lease cancel all claims (numbers 1 through 8) and substitute the enclosed new Claims (numbers 9 through 26)."

In regard to Applicants' letter of April 24, 2006, according to an Examiner at the U.S.P.T.O., who was later interviewed by Mrs. Susan Spranza in December 2008, the Examiner interpreted Applicants' letter of April 24, 2006 as a new Application. (See Spranza Decl., ¶4.) As

a result, the Examiner did not enter the preliminary amendment in Application '444, and instead filed the claims as a new application, U.S. Application Serial No. 11/416,516 (O/R: SDEV-1-1004) on May 2, 2006. (See Exhibit C, a true and accurate copy of the submission to the U.S.P.T.O. on May 2, 2006 for U.S. application Serial No. 11/416, 516, downloaded on March 9, 2009.)

While the record indicates that Applicants did not file the preliminary amendment in accordance with present the rules of the MPEP, the Applicants did indicate that they wanted to *cancel* claims. This direction to the Examiner is more consistent with an intention to file a preliminary amendment to the *existing* application. A preliminary amendment, if properly entered prior to the first Office Action, would not require an additional fee.

Regardless of the Applicants' intentions, the preliminary amendment was not entered for consideration in Application '444, and instead a fee determination record was entered by the Examiner in the *new* Application '516. Applicants did not respond to the notice to pay the fee nor submit other filing formalities for Application '516. As a result, Application '516 was abandoned on December 7, 2006 for failure to meet the requirements of a new application. Applicant Spranza was not aware of the existence of this new application and was also unaware of his and/or the Examiner's mistake, and therefore failed to take ameliorative measures. Applicant Spranza, in failing health, failed to resolve this issue with the U.S.P.T.O.

On July 9, 2007 the Examiner sent a non-final rejection in Application '444 to Applicant examining Claims 1-8, *not* Claims 9-26. Exhibit D is a true and correct copy of the non-final rejection sent July 9, 2007 as downloaded from U.S.P.T.O. PAIR on March 9, 2009.

On that same day, July 9, 2007, Mr. Spranza died. A true and correct copy of the State of California Certification of Vital Records dated July 24, 2007 recording the death of Joseph J. Spranza, III, is attached as Exhibit E. (See Spranza Decl., ¶3.)

When Mr. Spranza died, all of his estate, including the patent assets subject to the Spranza-Namba joint development agreement (*infra* Exhibit A), became part of a contested will and bankruptcy proceeding. From the time of death until the resolution and settlement of the then pending bankruptcy proceeding, the patent assets were part of the unsettled Spranza Estate/Bankruptcy Proceeding. Upon an Order of the Trustee's Motion to Approve a Distribution in Kind on March 31, 2008, the patent assets, including the above referenced patent properties,

were released to Mrs. Susan Spranza. A true and correct copy of the Trustee's Motion to Approve a Distribution in Kind of March 31, 2008 is attached as Exhibit F. (See Spranza Decl., ¶5.)

Two months later, on May 28, 2008, Application '444 was abandoned by the U.S.P.T.O. for failure to respond to the Office Action of July 9, 2007. The deceased, Mr. Spranza, was sent the Notice of Abandonment at his mailing address. A true and correct copy of the Notice of Abandonment, downloaded from U.S.P.T.O. PAIR on March 9, 2009 is included as Exhibit G. (See Spranza Decl., ¶6.)

During the period of July 2007- May 2008, and even thereafter, Mrs. Spranza was not represented by a patent attorney and was generally unaware of the status of pending applications and patents under her deceased husband's control. Mrs. Spranza was not involved in the operation of the company, and only began auditing her late husband's files after stabilizing the imminent threats of foreclosure on her property and eviction from her home which were precipitated by the death of her husband.

On August 26, 2008, Mrs. Susan Spranza, acting *pro se* and on behalf of her deceased husband, filed a response to the Notice of Abandonment together with a response to the Office Action of July 9, 2007. Responding to the last Office Action, Mrs. Spranza re-sent the instructions of August 24, 2006, that is, cancelling claims 1-8, and introducing new claims 9-26. She also sent a Petition with supporting documentation to grant her standing to revive the application from abandonment. A true and correct copy of the Petition filed on August 26, 2008 is included as Exhibit H. (See Spranza Decl., ¶7.)

On November 8, 2008, Mrs. Spranza contacted the law firm of Black Lowe & Graham, PLLC. At that time Mrs. Spranza sent a letter outlining her general situation and that of SDI. Preliminary conversations with Mrs. Spranza during November and December 2008 indicated that Mrs. Spranza had identified multiple patent applications and patent assets in her possession, but that these had complicated ownership issues and other problems that needed to be resolved prior to the properties' eventual sale (e.g., issues of multiple inventors, ownership, varied corporate licensing/assignments arrangements, etc.). At that time she also indicated that she may require help with the prosecution of Application '444.

On December 16, 2008 Mrs. Spranza received a Decision on Petition from the U.S.P.T.O., dismissing the Petition she had filed *pro se* on August 26, 2008 as having not met requirements (1) and (3) under the provisions of 37 C.F.R. 1.137(b). Specifically, under requirement (1) Applicant failed to execute the response that was included with the Petition, and under requirement (3) the Petition did not include a proper statement of unintentional delay since the Petition was signed by only one inventor. A true and correct copy of the Decision on Petition of December 16, 2008 is included as Exhibit I.

Thereafter, on January 8, 2009 Mrs. Spranza retained our firm. Thereafter Mrs. Spranzs forwarded to her undersigned representative the U.S.P.T.O.'s Decision on Petition and we immediately began all necessary steps to revive the abandoned application '444 .

Specifically, the undersigned first took steps to obtained Power of Attorney from Mrs. Spranza and co-inventor Dr. Namba. Next, on January 27, 2009, with Mrs. Spranza's assistance, the undersigned contacted Dr. Namba by telephone, and sent him the Power of Attorney to execute. A true and correct copy of the letter to Dr. Namba is included as Exhibit L. (See Spranza Decl., ¶8 and Namba Decl., ¶4.) On Monday, February 2, 2009, Dr. Namba executed the Power of Attorney document and mailed it to the undersigned who received the executed document on February 5, 2009.

Finally, on Friday, February 6, 2009, the executed Power of Attorney documents were submitted to the U.S.P.T.O. A true and correct copy of the executed Powers of Attorney are included as Exhibits J and L. (See Spranza Decl., ¶8 and Namba Decl., ¶4.)

On February 17, 2009 the undersigned finally received confirmation of the change of Power of Attorney in Application '444. A true and correct copy of the Notice of Acceptance of Power of Attorney from the U.S.P.T.O. is attached as Exhibit K.

Thereafter, we began examination of the records of the U.S.P.T.O. and began preparing the petition papers to revive Application '444 from unintentional abandonment. In the interest of filing this Petition in a timely manner, the undersigned notes that we are resubmitting the earlier *pro se* drafted claims in response to the Office Action of July 9, 2007 (*infra* Exhibits B-C). A full substantive review of the current application and its predecessor parent would have required additional time and potentially delay the filing of this Petition. We intend to file a preliminary

amendment with improved claims shortly after this application is revived, rather than risk delay of this Petition.

On March 12, 2009, Dr. Namba signed his supporting Declaration which was received by the undersigned on March 15, 2009. On March 18, 2009, Mrs. Spranza signed and mailed her supporting Declaration which was received by the undersigned on March 24, 2009.

For the reasons set forth above, as well as in the attached Declarations of Mrs. Spranza and Dr. Namba, the undersigned respectfully requests that the above-identified patent application be revived from unintentional abandonment. With this Petition, Applicants have demonstrated that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Moreover, the undersigned includes a Response to the last Office Action of July 9, 2007 in compliance with the requirement for this Petition.

If the Director requires additional information, or if there is any question as to whether the delay was unintentional, the Applicant requests that a telephone interview be granted.

Respectfully submitted,
BLACK LOWE & GRAHAM^{PLLC}
/WENDY M. GOMBERT/
Wendy M. Gombert
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Enclosures:

1. Declaration of Mrs. Susan Spranza with Exhibits A-K;
2. Declaration of Dr. Robert Namba with Exhibits A and L.

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